

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Office Action dated March 4, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Application. Claims 1 and 11 are independent claims.

In the Office Action, claim 12 is rejected under 35 U.S.C. §112, first paragraph. This rejection of claim 12 is respectfully traversed. It is respectfully submitted that the specification provides more than adequate support for the recitations provided in the claims. However, in the interest of expediting consideration and allowance of the claims, the Applicants have elected to amend the claims to recite "the aqueous surfactant solution is selected to bond to broken siloxane bonds in the micro-crack." Support for this limitation is provided in the specification, which for example makes clear that "the surfactants will connect to the broken siloxane bonds inside the micro-cracks." (E.g., see, present application on page 2, lines 1-11.)

As should be clear from the above discussion regarding the original disclosure of the present patent application, there is

more than ample support for the claim 12 recitation provided herein. Further, the Office Action acknowledges in a Response to Arguments section that "applicant only has coverage for surfactant bonding to broken siloxane bonds."

Accordingly, it is respectfully requested that the rejection of claim 12 under 35 U.S.C. §112, first paragraph be withdrawn.

Claims 1-4, 6, 8, 10-15, 17 and 19 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,211,488 to Hoekstra ("Hoekstra") in view of U.S. Patent No. 6,673,752 to Bookbinder ("Bookbinder"). Claims 5, 7, 9, 16, 18 and 20 are rejected under 35 U.S.C. § 103 over Hoekstra and Bookbinder in view of U.S. Patent No. 5,565,363 to Iwata ("Iwata"). These rejections of claims 1-20 under 35 U.S.C. §103(a) are respectfully traversed. It is respectfully submitted that claims 1-20 are allowable over Hoekstra in view of Bookbinder alone, and in view of Iwata for at least the following reasons.

OFFICE ACTION OF MARCH 4, 2009 IS IMPROPER FOR FAILING TO
ADDRESS THE ARGUMENTS CONTAINED IN THE AMENDMENT SUBMITTED ON
DECEMBER 8, 2008

In the Amendment Submitted On December 8, 2008 (hereinafter, "the Prior Amendment"), the Applicants addressed the rejection of claims 1-20 under 35 U.S.C. §103(a) in detail extending over pages 11-27 of the Prior Amendment, yet the (current) Office Action dated March 4, 2009, merely reiterates the prior rejection, word for word, from the August 6, 2008 Final Office Action, without even addressing a single point raised by the Prior Amendment regarding the rejection of claims 1-20 under 35 U.S.C. §103. In fact, the Response to Arguments section of the Office Action, and all of the Office Action for that matter is completely silent regarding the points raised by the Applicants in the Prior Amendment other than to address the prior rejection of claim 12.

The MPEP in §707.07(f) makes clear that (emphasis added) "[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application." The MPEP further provides that (emphasis added) "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

In the Prior Amendment, the rejection of claims 1-20 under 35 U.S.C. §103(a), is traversed starting on page 11, yet the Office Action fails completely to address the points raised in the Prior Amendment.

In the MPEP in §707.07(f), the Examiner Note 1 states that (emphasis added) "[t]he examiner must address all arguments which have not already been responded to in the statement of the rejection."

Further, the claims as presented in the Prior Amendment were amended, yet the Office Action fails to address the then newly presented claim language in any form. As indicated above, the rejection of claims 1-20 under 35 U.S.C. §103(a) in the Office Action is word-for-word the same rejection previously provided prior to the amended claim language.

Yet, MPEP in §707.07(f) makes clear that "[i]f a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given" although the Office Action does not provide any such recitation.

Accordingly, since the Office Action has failed to address the points raised in the Prior Amendment including an amendment to the claims presented in the Prior Amendment, it is respectfully requested that should the rejection of claims 1-20 under 35 U.S.C. §103(a) be maintained in a subsequent Office Action, the subsequent Office Action should be rendered Non-Final to provide the Applicants an opportunity to respond to any points raised.

CLAIMS 1-20 ARE NONOBVIOUS OVER HOEKSTRA IN VIEW OF BOOKBINDER ALONE, AND IN VIEW OF IWATA

Claim 1 of the present application recites and claim 11 similarly recites (emphasis added) "focusing a laser beam on an exposed surface of the substrate to heat the exposed surface of the substrate with the laser beam to create a heated spot on the exposed surface of the substrate, moving the laser beam and the substrate with respect to each other to create a line of heated spots on the exposed surface of the substrate, cooling the heated spots on the substrate by locally applying a cooling medium such that a micro-crack in the line of heated spots is propagated on the exposed surface of the substrate, and breaking the substrate along

the line of the propagated micro-crack by applying a force on the substrate wherein the cooling medium comprises an aqueous surfactant solution."

Hoekstra shows an apparatus that utilizes a laser and a cooling stream together with breaking beams to break a substrate. Hoekstra provides (emphasis added) "[a]n apparatus and method for physically separating non-metallic substrates [that] forms a microcrack in the substrate and controllingly propagates the microcrack." Hoekstra stipulates that the (emphasis added) "crack inside the substrate that does not extend to either the upper or lower surface." (See, Hoekstra, abstract.)

Hoekstra makes clear that (emphasis added) "the focal point 37 of the laser 34 may be vertically positioned within the substrate 4 as desired. In a preferred arrangement, the focal point of the pulsed laser is within the thickness of the substrate 4, slightly below the upper face of the substrate 4. For example, for a glass sheet having a thickness of approximately 1 mm, the focal point should be 5-50% or 0.05-0.50 mm, from the upper surface, preferably about 0.1 mm. However, the preferred depth of the focal point may depend on the thickness of the substrate to be split." (See, Hoekstra, FIG. 4 and the accompanying description contained in Col.

5, lines 49-61.) As shown in FIG. 4, "[t]he pulsed laser 34 through the lens 35 creates a void 37 in the substrate from the edge of the substrate 4 inward at a certain distance below the upper face of the substrate 4." (See, Hoekstra, Col. 5, lines 62-64.)

Clearly Hoekstra teaches a laser that is focused within the substrate below a surface of the substrate.

In addition, Hoekstra further makes clear that it is only when the substrate is introduced to the break beams 44, 46 wherein (emphasis added) "the break beams 46 and 48 heat the regions on both sides of the microcrack to create tensile forces to that are sufficient to separate the substrate 4 along the separation line 45 from the microcrack to the bottom surface." (see, Hoekstra, Col. 6, lines 45-49.) It is respectfully submitted that Hoekstra unequivocal language makes clear that the microcrack, prior to introduction to the break beams 44, 46, does not extend to the surface of the substrate. Hoekstra teaches that benefit of this microcrack formation is that "the laser scribe initiation device 24 eliminates inherent drawbacks of a mechanical scribe initiation system. For example, the use of the laser scribe initiation device

24 eliminates any particulate material that may be generated by mechanically forming the microcrack."

As should be clear to a person of ordinary skill in the art, forming the microcrack on the surface of the substrate, even with a laser, would have the same drawback of creating particulate matter. Accordingly, as should be clear, Hoekstra teaches forming the microcrack in the substrate and teaches away from forming the microcrack on the surface of the substrate.

While Bookbinder is also cited in rejecting claims 1-20, Bookbinder is only cited for showing a surfactant and as such, does nothing to cure the deficiencies of Hoekstra.

It is respectfully submitted that the method of claim 1 is not anticipated or made obvious by the teachings of Hoekstra in view of Bookbinder. For example, Hoekstra in view of Bookbinder does not disclose or suggest, a method that amongst other patentable elements, comprises (illustrative emphasis provided) "focusing a laser beam on an exposed surface of the substrate to heat the exposed surface of the substrate with the laser beam to create a heated spot on the exposed surface of the substrate, moving the laser beam and the substrate with respect to each other to create a line of heated spots on the exposed surface of the substrate,

cooling the heated spots on the substrate by locally applying a cooling medium such that a micro-crack in the line of heated spots is propagated on the exposed surface of the substrate, and breaking the substrate along the line of the propagated micro-crack by applying a force on the substrate wherein the cooling medium comprises an aqueous surfactant solution" as recited in claim 1, and as similarly recited in claim 11. Clearly in Hoekstra, the laser is focused in the substrate and the heated spot and micro-crack is purposefully propagated in the substrate without extending to the outer or lower surface of the substrate. Iwata is cited in rejecting dependent claims and as such, does nothing to cure the deficiencies in each of Hoekstra and Bookbinder.

For at least this reason and based on the foregoing, the Applicants respectfully submit that independent claims 1 and 11 are patentable over Hoekstra in view of Bookbinder and notice to this effect is earnestly solicited. Claims 2-10, 12-20 respectively depend from one of claims 1 and 11 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

CLAIMS 1-20 ARE ALLOWABLE OVER HOEKSTRA IN VIEW OF BOOKBINDER
BECAUSE THERE IS NO PROPER MOTIVATION FOR COMBINING HOEKSTRA AND
BOOKBINDER

It is respectfully submitted that for the above rejection, the Office Action cites a motivation to make a combination of references that finds no support in the cited references.

With regard to the rejection of claims 1-20 as being obvious from Hoekstra in view of Bookbinder alone, and in view of Iwata, the Office Action states that (emphasis provided) "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to use the surfactants (cationic, nonionic or anionic) and the surfactant concentration (0.1 to 1.0%) as taught by Bookbinder et al. in the Hoekstra et al. process because coolants and cutting fluids function as one and the same (i.e. interchangeable). Furthermore, both Bookbinder et al. and Hoekstra et al. are directed to the machining of brittle materials." This position is respectfully traversed.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a **prima facie** case of obviousness. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1442,

1444 (Fed. Cir. 1992). **See also In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. **In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ 1430, 1433 (Fed. Cir. 2002), **citing McGinley v. Franklin Sports, Inc.**, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." **Id.** "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 1000, 50 USPQ2d at 1617, **citing McElmurry v. Ark. Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

The suggestion in the Office Action that the combinations of prior art references "would be obvious to one having ordinary skill

in the art ... " is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention. The Federal Circuit has identified three possible sources for motivation to combine references including the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. (See, *In re Rouffet*, U. S. Court of Appeals Federal Circuit, U.S.P.Q. 2d, 1453, 1458.) There must be a specific principle that would motivate a skilled artisan, with no knowledge of the present invention, to combine the prior art as suggested in the Office Action. The use of hindsight in the selection of references is forbidden in comprising the case of obviousness. Lacking a motivation to combine references, a proper case of obviousness is not shown (see, *In re Rouffet*, 1458).

The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) in the *In re Rouffet*, holding. The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of

the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them.

The Office Actions reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Hoekstra with Bookbinder, could only have been made with hindsight based on the teachings of the present disclosure. The Examiner's reasoning for the motivation for combining the references is nowhere recognized in the prior art.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art

component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants again respectfully submit that the Office Action has used impermissible hindsight to reject claims 1-20 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

The mere fact that the prior art device could be modified so as to produce the claimed device, which in this case even in combination it does not (as discussed in detail above), is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); and *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989).

How can the Office Action espouse that this reconstruction forwarded does not include knowledge gleamed only from the

Applicants disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art.

It is respectfully submitted that Bookbinder relates to cutting fluids. Bookbinder's cutting fluids are typically used for cutting by a saw blade (see, Bookbinder, abstract). Bookbinder's cutting fluids are used for cooling the saw blade heated by frictional heat of a workpiece (see, Bookbinder, Col. 2, lines 14-16). Bookbinder's cutting fluids help provide a slippery surface for the saw blade, but do not act on the workpiece. As shown in FIG. 1 of Bookbinder, the cutting fluid is applied to the cutting blade and not to the material being cut. The organic solution binds to chips that are cut away from the material being cut to keep the particles from clogging the abrading surface of the cutting blade (see, Col. 2, lines 51-61).

On the other hand, Hoekstra relates to laser scribing. Quenching fluids used by Hoekstra directly contribute to scribing a substrate. Namely, the substrate in Hoekstra is scribed by a temperature gap. As stated in Hoekstra, "[t]he temperature differential between the heat affected zone of the substrate and the coolant stream propagates the micro-crack." (See, Hoekstra,

abstract.) The temperature gap arises from laser heating and "quenching by the quenching fluids".

It is respectfully submitted that the functions of a quenching fluid used for laser scribing are much different from those required for cutting fluids used for cutting workpieces by a saw blade. Further, a person of ordinary skill in the art that is applying Hoekstra, would not look to Bookbinder which teaches a saw blade since, Hoekstra is directed to avoiding the problems caused by the saw blade approach, such as taught by Bookbinder (see, discussion above).

Therefore, it is respectfully submitted that there is no motivation found in the prior art references for the man skilled in the art to use Bookbinder's cutting fluids in place of the quenching fluids for Hoekstra's laser scribing. In cutting workpieces, small particles are not generated by a laser beam unlike the case of a saw blade and accordingly, there would be no reason to apply the teaching of Bookbinders cutting fluid which is taught by Bookbinder to lubricate a cutting blade and wash away particulate. Therefore, there is no teaching contained within either of Hoekstra or Bookbinder of using surfactant for laser scribing.

In consideration of the use of improper hindsight for rendering a claim obvious in light of prior art, the Federal Circuit has stated that "to draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction - an illogical and inappropriate process by which to determine patentability." (Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 38 USPQ2d 1551 (Fed. Cir. 1996)). "To imbue one of ordinary skill in the art with knowledge of the invention ensued, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." (In re Zurko, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997)). "A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field (cited reference omitted). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the

insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher (cited references omitted).'" (In re Kotzab, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)).

Applicants would like to bring to the Examiner's attention well established case law that clearly shows that the court frowns on such use of hindsight, examples of such cases being as follows:

It is stated in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983): "prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

It is clear that the suggestion to combine references should not come from Applicants, as was forcefully stated in Orthopedic Equipment Co. v United States, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983): "It is wrong to use the patent in suit [here the application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

Also, the case law is clear in guarding against the use of hindsight in reading Applicants invention into the prior art, which art is clearly not disclosing the Applicants invention as claimed. Applicants would like to bring the following cases to the Examiner's attention:

The Supreme Court in Calmar, Inc. v. Cook Chemical Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966), in which the Court warns the dangers of "slipping into hindsight", citing the case of Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 141 U.S.P.Q. 549 (6th Cir., 1964), where the doctrine is stated (emphasis provided):

We now come to the patented device which after all is the subject matter of this case. At the outset we take note of two well-established principles. The first is that in considering the questions of obviousness, we must view the prior art from the point in time prior to when the patented device was made. Many things may seem obvious after they have been made and for this reason courts should guard against slipping into use of hindsight. We must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of Sporck, 301 F.2d 686, 689 (C.C.P.A).

The courts have long held that there must be some teaching in the references cited to suggest the combination of the references in a manner to obtain the combination of elements of the rejected

claim(s). It is well known that in order for any prior art references themselves to be validly combined for use in a prior-art § 103 rejection, the references themselves, or some other prior art, must suggest that they be combined. For example:

The Board has stated in *Ex parte Levengood*, 28 USPQ 2d 1300 (PTOBA&I 1993):

In order to establish prima facie case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ... That which is within the capabilities of one skilled in the art is not synonymous with obviousness ... That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention ... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden establishing a prima facie case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references which describe various aspects of a patent applicant's invention without also providing evidence of a motivating force which would impel one skilled in the art to do what the patent applicant has done.

As was further stated in *Uniroyal, Inc. v Rudkin-Wiley Corp.*,
5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "where prior art references
require selective combination by the court to render obvious a
subsequent invention, there must be some reason for the combination
other than hindsight gleamed from the invention itself ...
Something in the prior art must suggest the desirability and thus
the obviousness of making the combination."

The Applicants respectfully maintain that there is no
suggestions in the prior art references to make the combinations in
the manner proposed by the Examiner to achieve the Applicants
claimed invention.

The Examiner is requested to consider MPEP 2143, wherein it is
stated:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE
CLAIMED INVENTION ... The teaching or suggestion to make
the claimed combination and the reasonable expectation
of success must both be found in the prior art, not in
applicant's disclosure. In re Vaeck, 947 F.2d 488, 20
USPQ2d 1438 (Fed. Cir. 1991)." And, "FACT THAT
REFERENCES CAN BE COMBINED OR MODIFIED IS NOT
SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS ...
The mere fact that references can be combined or
modified does not render the resultant combination
obvious unless the prior art also suggests the
desirability of the combination. In re Mills, 916 F.2d
680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a
prior art device "may be capable of being modified to

run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.).

Further, the Office Action takes a position that "both Bookbinder et al. and Hoekstra et al. are directed to the machining of brittle materials." This position is respectfully traversed. While it is true that Bookbinder is directed to machining, Hoekstra specifically teaches avoiding a machining process.

As a person of ordinary skill in the art would readily appreciate, (emphasis added) "machining ... is a collection of material-working processes in which power-driven machine tools, such as lathes, milling machines, and drill presses are used with a sharp cutting tool to mechanically cut the material to achieve the desired geometry." (see, Machining, (2009, May 27), In Wikipedia, The Free Encyclopedia. Retrieved 17:59, May 27, 2009, Internet at en.wikipedia.org/w/index.php?title=Machining&oldid=292710528.)

Accordingly and in contrast with what is asserted in the Office Action, Hoekstra and Bookbinder are in different fields of endeavor and in fact, Hoekstra specifically teaches to avoid a machining process such as is the subject matter of Bookbinder.

Accordingly, it is respectfully submitted that in light of the state of the law as set forth by the Federal Circuit and the lack of motivation to combine the cited references, and in fact the specific teachings in Hoekstra of avoiding processes such as taught by Bookbinder, it is respectfully submitted that none of the suggested combinations of prior art utilized to reject each of claims 1-20 finds proper motivation for combination. Further, since the Final Office Action acknowledges that neither of Hoekstra and Bookbinder alone show the claimed features, it is respectfully requested that claims 1-20 be allowed for these additional reasons and an indication to that effect is respectfully requested.

Further, as noted above, even in combination Hoekstra in view of Bookbinder does not disclose or suggest the inventive features of claims 1-20.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position,

should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 

Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
June 4, 2009

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101